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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,044	09/13/2003	David J. Laverick	702.270	1972

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EXAMINER

DIACOU, ARI M

ART UNIT	PAPER NUMBER
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3663

MAIL DATE	DELIVERY MODE
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07/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/663,044	Applicant(s) LAVERICK ET AL.	
	Examiner Ari M. Diacou	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,13,14 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,13,14 and 30-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5-15-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. In the remarks filed 5-10-2007, applicant argued the following:
 - A. On page 14, that the specification has been amended as suggested by the examiner, and objections should be withdrawn.
 - B. On page 14, that the limitation 'such that no securing mechanism is needed to secure the case within the tray', contrary to the 112P1 rejection, is enabled by the specification.
 - C. On page 15, that 'originally installed during the manufacture of the vehicle' is not indefinite.
 - D. On page 17, that "clearly anticipated" is an improper rejection.
 - E. On page 17, that the examiner did not give consider claim limitations.
2. Argument A is convincing, the objections are hereby withdrawn.
3. Argument B is unconvincing, the specification and the drawings cited by the examiner seem to enable a lip or recess in the dashboard, not 'no securing means'.
4. Argument C is unconvincing. There is no structure within the offending limitation with which to limit the claim. Furthermore, the applicant's evidence of enablement does not serve to clarify the scope of the claims.
5. Argument D is unconvincing. Saying claim limitations are "clearly anticipated" by a reference is appropriate when one of ordinary skill in the art would ascertain very

easily what elements corresponded to the claimed features without being told beforehand. See form paragraph 15.12.

6. Argument E unconvincing. The claims were considered, and given weight according to their clarity, and how much they limited the invention, which was not much in either case. The claims did clearly specify what structures were inside or outside their scope (hence the indefiniteness rejection) and since no structures seemed to be excluded by the claim limitation, the claim was considered to read on Schoenfish.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first two paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 40-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "No securing mechanism" is not enabled, if something is not secured, it falls toward the center of the earth. In the instant application's specification, the securing means is at least Fig. 26, 182i. In the interests of compact prosecution, the examiner will assume that "no securing means" reads on a recess whose face has a normal vector substantially antiparallel to the weight vector of the navigational device.

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9. Claims 1 and 3-8, 13, 31-39 and 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding claims 2, 31 and 42, "originally installed during the manufacture of the vehicle" is indefinite for failing to limit what is added to the structure by this limitation. In the interest of compact prosecution, the examiner will prosecute the claims under the assumption that the above claim language adds no structural limitations to the inventions of claims 1, 31 and 41.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3-8, 13, 14 and 30-46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Toshiaki (IDS filed 11-21-2006).

12. Claims 1, 3-4, 14, 31-33 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoenfish et al. (USP No. 6370037).

- Regarding claims 1, Schoenfish discloses a navigation assembly for use in a vehicle comprising:
 - a navigational device; and [Fig. 1, #12]

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- a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, [Fig. 1, #14]
 - wherein the case is configured to conform to the tray. [Fig. 2]
 - wherein the tray is originally installed in the vehicle during manufacture of the vehicle. [Fig. 1, #68]
- Regarding claims 31, Schoenfish discloses a navigation assembly for use in a vehicle comprising:
 - a navigational device; and [Fig. 1, #12]
 - a carrying case sized and configured to conform to a tray of the vehicle, [Fig. 1, #14]
 - *wherein the tray is originally installed in the vehicle during manufacture of the vehicle* [This language does not structurally limit the claimed invention.]
 - wherein the carrying case may be removed from the tray with the navigational device substantially enclosed therein. [Fig. 2]
- Regarding claim 2, Schoenfish's device could be installed during the manufacture of the vehicle.
- Regarding claim 3 and 32, Schoenfish discloses [Abstract].
- Regarding claims 14 and 38, the limitations thereof are inherent to all GPS devices disclosed by Schoenfish.
- Regarding claims 4 and 33, Schoenfish discloses Col. 5, lines 10-18.

13. Claims 41-42 and 45-46 are rejected under 35 U.S.C. 102(b) as being on sale (or in public use) more than one year before the filing date of the invention, as evidenced by Amazon.com's advertisement of the "Garmin 010-10314-00 Carry Case", which was available for sale at latest on 2 October 2001.

- Regarding claim 40, as best understood by the examiner, Amazon.com discloses a navigation assembly for use in a vehicle comprising:
 - a navigational device; and [Device inside the carry case]
 - a carrying case [Neoprene case] configured to substantially enclose the navigational device, the case being sized and configured to fit within a tray on a dashboard of the vehicle [A cup holder reads on the tray]
 - such that no securing mechanism is needed to secure the case within the tray. [As discussed above, a cup holder reads on the examiner's interpretation of what the applicant means.]
- Regarding claim 41, cup holders are originally installed in vehicles.
- Regarding claim 42, Amazon.com discloses the navigation assembly as claimed in claim 40, wherein the carrying case includes a base and a hinged lid [the neoprene flap], such that when the navigational device is pivoted to a flat, nesting position within the case, the lid is operable to enclose the navigational device, and when the navigational device is pivoted upwards in a viewing position, the lid is operable to pivot upwards and rest generally against a top of the navigational device.

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- Regarding claim 45, Amazon.com discloses the neoprene flap, when closed, being placed vertically above the "base"/bottom of the carry case, thereby the flap enclosing the bottom of the carry case.
- Regarding claim 46, one would only have to reach into the cup holder and grab the case/navigator.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over amazon.com as applied to claim 40 above, and further in view of official notice.

- Regarding claim 43, Amazon.com discloses the invention with all the limitations of claim 40, but fails to disclose a navigator with a speaker. It is well known in the art that GPS navigators can contain speakers. Therefore, it would have been obvious to one skilled in the art (e.g. design engineer) at the time the invention was made, to make a case that fit around a GPS navigator with a speaker, for the advantage of protecting the audible navigator.
- Regarding claim 44, when the hinged flap is open, one can still see the screen through the plastic window, it is thereby in a viewing position.

18. Claims 5-8, 13, 30, 34-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish as applied to claims 1 and 31 above, and further in view of Trumbull (USP No. 6125030).

- Regarding claim 5, Schoenfish discloses the invention with all the limitations of claims 1 and 31, but fails to disclose a lid. Trumbull teaches a compartment with a hinged lid that could be used to enclose the device of Schoenfish. Therefore, it would have been obvious to one skilled in the art (e.g. an optical engineer) at the

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time the invention was made, to place device of Schoenfish in the compartment of Trumbull, for the advantage of protecting the device of Schoenfish.

- Regarding claims 6 and 35, Schoenfish discloses [Abstract].
- Regarding claims 7 and 36, Schoenfish's device has a speaker, therefore, it would be contained in the case of Trumbull in the obvious combination described above.
- Regarding claims 8, 30, 37 and 39, Trumbull's device has a recessed base that would enclose the navigational device, and the speaker enclosed therein. Therefore, both would be positioned within the base of the case.
- Regarding claims 13, 30, 34, 37 and 39, in the obvious combination described above, the device of Schoenfish would be placed between the hinged lid and the recessed based, thereby meeting the claimed limitation.

Conclusion

19. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

20. The references made herein are done so for the convenience of the applicant. They are in no way intended to be limiting. The prior art should be considered in its entirety.

21. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

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22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

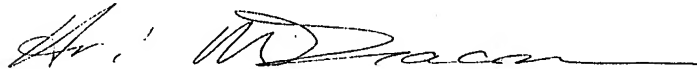
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JACK KEITH
SUPERVISORY PATENT EXAMINER

7/11/2007